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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/820,887 | 04/09/2004 | Takahiro Ishioroshi | Q80648 | 9258 |
| 7590 06/23/2005 | | | | |
| SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213 | | | EXAMINER KIM, AHSHIK | |
| | | | ART UNIT 2876 | PAPER NUMBER |

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/820,887 | ISHIOROSHI, TAKAHIRO | |
| | Examiner | Art Unit | |
| | Ahshik Kim | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on March 29, 2005. In the amendment
5 the independent claims 1 and 9 were amended. Currently, claims 1-11 remain for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

- 15 3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Outwater et
al. (US 6,354,501, hereinafter "Outwater") in view of Kusumoto et al. (US 6,295,262, hereinafter
"Kusumoto")

Re claims 1, 5-7, 9, and 10, Outwater discloses a barcode label which contains both
20 visible portion of the code and an invisible portion of the code under normal (or visible) lighting
environment (see abstract; col. 2, lines 51+; col. 3, lines 52+). The invisible portion of the code
is coded by an UV (ultraviolet) ink or fluorescent ink (col. 1, lines 60-67). The code is visible
when illuminated by a particular spectrum of ultraviolet light (col. 1, lines 51-59). The UV or
fluorescent ink does not react to the visible spectrum (380-770 nm) but is visible when
25 illuminated with light in the UV spectrum (200-380 nm).

Outwater, disclosing an application where the label is used for marking CDs and audio and video cassettes (col. 1, lines 31-4)), fails to specifically teach or fairly suggest that the label is formed by applying a surface layer on a base layer, and removing a portion of surface layer with a laser beam.

5 Kusumoto teaches a method for recording information such as a barcode on an optical disk (see abstract) wherein a portion of the surface layer is removed by applying a laser beam (col. 1, lines 33-47).

In view of Kusumoto's, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known laser etching method of marking a barcode
10 to the teachings of Outwater in order to improve durability of the barcode applied on the item. It is the Examiner's view that printing barcode, attaching a barcode label, or etching or engraving a barcode with laser are functionally equivalent means to apply a barcode on an item. Each method have its own advantages and drawbacks. It is well within one ordinary skill in the art to pick a particular embodiment suiting their application. It is also the Examiner's view that the
15 above-mentioned methods can be combined.

Re claim 11, the pressing the foil against the article, the section of the article contacting the blank portion of the foil is exposed to be printed (col. 4, lines 57+; see claim 3).

Re claims 2-4, the ink is applied by one of hot stamping, thermal ribbon printing or ink
20 jet printing methods (col. 4, line 66 – col. 5, line 4). In applying hot stamping, a hot stamping foil 50, which may be plastic, mylar, polypropylene or polyester is used to print he mark 10 onto an article (col. 4, lines 44+).

Re claim 8, the light receiving section includes an IR light blocking filter 160 (col. 5, lines 54+).

Response to Arguments

- 5 4. Applicant's amended claims and remarks filed on March 29, 2005 have been carefully considered. Examiner acknowledges Applicant's amending claims to overcome the Outwater patent. Remarks regarding the amended claims have been carefully considered. However, amended claims warranted additional search and considerations.

Applicant's arguments with respect to the amended claims further clarifying the claims
10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).
15 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period
20 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Wolpert et al. (US 6,255,948); Moh et al. (US 6,214,250) disclose laser-marked barcode and other markings. Applicant is respectfully suggested to carefully review these references.

5 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

15 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

20 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim
Patent Examiner
Art Unit 2876
June 15, 2005

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